

8-21-3 61

AP/1600



Docket No. 104.002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Eugene S. Pearlman

SERIAL NO.: 09/303,315

GroupArtUnit:1631

FILED: April 30, 1999

Ex: Lori A. Clow

FOR: ALGORITHMIC TESTING IN LABORATORY MEDICINE

RECEIVED

RESPONSE AFTER FINAL UNDER 37 CFR 1.116

AUG 25 2003

Commissioner for Patents
Alexandria, VA 22313-1450

TECH CENTER 1600/2900

Sir:

In response to the outstanding final action dated July 16, 2003, February 5, 2003, applicant files the following remarks. Before doing so, applicant has instructed his attorney to file a grievance against the Examiner, Dr. Lori L. Clow, for having failed to follow reasonable examination procedures in this application. MPEP 2164.04 spells out the principles of compact prosecution and applicant believes that the Examiner has not met her burden for reasons outlined below.

As background, on May 5, 2003, applicant filed a Request for Continued Examination, with an Amendment Under 116. These papers were filed after applicant's attorney held a telephone interview with both Examiner Lori Clow and Dr. Michael Woodward, on April 25, 2003. At the end of this interview, Applicant's attorney requested a follow-up interview with both Examiners, to

discuss any outstanding issues, should Examiner Clow deem it necessary.

On July 8, 2003, Examiner Lori Clow called applicant's attorney and stated that her examination of the application (and Amendment under 37 CFR 1.116) had resulted in her decision to issue an allowance. Examiner Clow indicated that she required an Examiner's amendment regarding canceling claim 22. Applicant's attorney agreed to the amendment. Applicant's attorney informed applicant the news of the impending allowance.

On July 16, 2003, Examiner Clow issued a Final Office Action raising the issue of new subject matter in reference to the claim amendment "without the intervention of a technician".

Applicant's attorney called the Examiner on July 18, 2003 to discuss the Final Office Action (in view of the allowance by the Examiner in her July 8, 2003 telephone). Applicant's attorney left a message about the Final Action, and asked the Examiner to call her back. The Examiner did not do so. Therefore, applicant's attorney called the Examiner's Supervisory Patent Examiner on July 21, 2003 and presented the facts (a telephone allowance on July 8, 2003 followed by a Final Action on July 16, 2003) to Dr. Michael P. Woodward. Dr. Woodward indicated that he would request the file and review it and give his comments by calling the applicant's attorney as soon as he could.

Dr. Woodward has not called. In the interest of compact prosecution and the 2 month deadline after Final, applicant is submitting this amendment.